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REMARKS

In response to the Office Action dated 11/02/2004,
please amend this application as follows:

IN THE CLAIMS:

Cancel claims 1 to 5.
Amend claims 6 to 10.
Add new claims 11 to 17.

Claims 6 to 17 are now in the application.

Claims 6 to 10 have been amended to be dependent on new
claims 11 to 15. New claim 17 is similar to claims 6 to 10 and is
dependent on new claim 16.

New claim 11 corresponds generally to former claim 1
and part of former claim 2. New claim 14 corresponds generally to
former claim 1 and part of former claim 4. New claims 12 and 13
correspond generally to claims 2 and 3. New claims 15 and 16
correspond generally to former claims 4 and 5.

With new claims 13 and 16, the claim language has been
amended to conform to the language used in the specification and
thus the objections to both the specification and the claims,
raised in paragraphs 2 and 5-7 of the Office Action, are believed
to be overcome.

New claim 11 is believed to patentably distinguish over
the Martin U.S. Patent 652,128 as applied under 35 U.S.C. 102(b).
New claim 11 calls for a stock bearing (one that is bought off
the shelf in a store) to be press fit mounted in one of the bore
or counterbore formed in the top member. Claim 11 further calls
for an annular raceway for receiving the balls forming the second
bearing means with half of the raceway formed in the cylindrical
wall defining one of the bore and counterbore. Claim 11 further
calls for the bottom caster member to have a stub shaft. Martin
shows none of the above three features so he cannot be said to
anticipate the claim under 35 U.S.C. 102(b).

Applicant's invention involves the use of a stock or
store bought bearing. The unit is quickly and easily assembled
using such a bearing. In Martin, both bearings involve the use of
separate balls. The assembly of the unit is therefore much more
difficult than the assembly of applicant's unit. A more important
difference is having the one bearing mounted in a raceway half of
which is formed in a cylindrical wall of one of the bore or
counterbore. In Martin, the bore in the cup-shaped body 'a' of
the caster has no raceway formed in its cylindrical wall. The

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ball race 'c' in the patent is formed in the annular wall at the top of the bore but not in the cylindrical wall of the bore. And there is no raceway formed in the cylindrical wall of the counterbore. There is an annular portion in the counterbore which provides a raceway 'd' for the balls of the second bearing but there is no raceway in the outer cylindrical wall of the counterbore.

Applicant's construction uses the bearing balls in the second raceway to prevent the bottom member of the caster from separating from the top member. To prevent this separation, the balls have to extend partially into the top member and partially into the bottom member, the balls spanning the vertical plane of separation between the members. The balls 'm' in Martin do not prevent separation of the two members nor do the balls 'l'. The two members in Martin are prevented from separating only by the use of a top pin 'j' that locks one member within the other. If the pin is removed the bottom member and both sets of balls would drop out.

Claim 11 also calls for a stub shaft on the bottom caster member extending into a bore on the top caster member. Martin does not have a stub shaft and, in using the rod or pin 'i', has no use for a stub shaft.

In view of the three differences discussed, it is believed that new claim 11 patentably distinguishes over Martin, as applied under 35 U.S.C. 102(b), and also if Martin were to be applied under 35 U.S.C. 103(a). Martin employs a caster with a long threaded leg extending upwardly which is used to connect the caster to furniture. The leg, together with the rod or pin inside it, is like a king-pin normally used in casters. Applicant does not employ a caster with a king-pin. In lieu of a king-pin with a clip or pin to hold the caster members together, applicant employs one of the bearing means that consists of individual balls. A clip or pin, such as used in Martin, often fails, or loosens and drops off, causing separation of the caster parts. In applicant's construction, the balls are retained in the raceway and the caster does not fail by having the parts separate.

Claim 14 is similar to claim 11 but with the stub shaft extending downwardly from the top member into a bore in the bottom member. The claim has essentially the same differences from Martin as claim 11 and is believed to patentably distinguish over Martin for the same reasons that claim 11 distinguishes thereover.

Claims 12 and 15 are specific to the raceway being between the stub shaft and the bore with the raceway formed in

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the cylindrical walls of the stub shaft and the bore while claims 13 and 16 are specific to the raceway being between the cylindrical wall of the counterbore and the cylindrical wall of the step supporting the stub shaft.

The examiner has questioned the use of the phrase 'stock bearing' in the claim. A stock bearing is a bearing one is able to buy in a store. Such a bearing comes with raceways for the ball bearings that it carries, and means for keeping the raceways, and thus the balls, together as a single unit. A 'stock bearing' is quite different in construction from the separate balls used in the second bearing means. The second bearing needs raceways on the caster members to mount the balls. The term 'stock bearing' implies no process limitations in the claim. Applicant is not concerned with, nor is applicant claiming, any process limitations by referring to a 'stock bearing' but rather is referring to a specific type of bearing compared to the type of bearing distinguished by separate, unconnected balls.

The examiner has also questioned the use of the term 'press fit' in the claim as being a process limitation. The term is a process limitation if the term is used in the verb or action sense but it is a structural limitation when used as an adjective or in a modifying sense. In the present case, the term 'press fit' defines how the bearing is mounted and held in place and not how it is put in place. The term 'press-fit', in the context it is used, defines a structural limitation in the caster.

Claims 11 to 16 are believed to patentably distinguish over the Moore U.S. patent 2,960,717 as applied under 35 U.S.C. 103(a). Claim 11 calls for a bottom member having a (integral) stub shaft extending up therefrom. The stub shaft in Moore is a separate member from the bottom member. Claim 11 also calls for a raceway formed in the cylindrical wall defining one of the bore and counterbore. No such raceway is shown in Moore. Claim 14 calls for a (integral) stub shaft extending down from the top member. The claim also calls for a raceway formed in the cylindrical wall defining the bore or counterbore.

Moore shows neither feature. Moore uses a separate bolt, forming a king-pin, to connect the top and bottom members of the caster together. The Moore caster is thus much more complicated than applicant's caster. In addition, the nut and bolt king-pin in Moore can separate during use causing separation of the caster parts. The balls used as bearings in applicant's construction remain in place during use of the caster and the balls thus always maintain the connection between the caster parts. Since the remaining claims are dependent, either directly

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or indirectly, on claims 11 and 14 all the claims are believed to patentably distinguish over Moore.

Applicant's agent has noted the examiner's objection to the specification and claims in paras. 4 and 6 of the Office Action as having words where the letter 'e' in the word has not printed. Applicant's copy of the application shows the specific words pointed out by the examiner, as examples of the defect, in both the specification and claims, as having the letter 'e' in the correct place. Further, the letter still prints in the word on a printout obtained on applicant's printer.

A discussion of the problem by phone with examiner Kyle appears to indicate a problem with the Patent Office scanner. Examiner Kyle indicated that a supplementary Action would be issued deleting this objection. Therefore no correction to the objection is being made at this time.

Respectfully submitted,

Applicant's Agent

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